

## **REMARKS**

### **I. Introduction**

Claims 1 to 9 are currently pending. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claim 1 Under 35 U.S.C. § 103(a)**

Claim 1 was rejected under 35 U.S.C. §103(a) as unpatentable over the combination of Pauschinger (U.S. Patent No. 6,523,014), Sakakibara (U.S. Patent No. 6,798,463) and Cilurzo (U.S. Patent No. 6,434,526). Applicants respectfully submit that the combination of Pauschinger, Sakakibara and Cilurzo does not render unpatentable claim 1 for the following reasons.

While the "Response to Arguments" section of the Final Office Action purports to recognize that obviousness can only be established by combining or modifying references to produce the claimed subject matter where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, the Final Office Action goes on to state that there is sufficient motivation to combine the Pauschinger, Sakakibara and Cilurzo because "all three references are in the domain of managing data" and "due to the fact that they are all involved in the process of data management/handling using a computer." Final Office Action at page 2. It is respectfully submitted that whether the references relied upon may pertain to the general technical area of data management does not provide sufficient support for sustaining a prima facie assertion of obviousness under 35 U.S.C. §103(a).

On the issue of the motivation for combining references, the Federal Circuit has recently provided that:

There must be a teaching or suggestion within the prior art, within the nature of the of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention **to look to particular sources, to select particular elements, and to combine them as combined by the inventor.**

Crown Operations International Ltd. v. Solutia Inc., 289 F.23d 1367 (Fed., Cir. 2002) (emphasis added).

It is respectfully submitted that the Office Actions to date have been deficient in demonstrating how one of ordinary skill in the art would have been motivated to look to and combine specific elements of the references relied upon without first having knowledge of the present application. Rather, the asserted combination is representative of the type of hindsight reconstruction which has repeatedly been warned against in the relevant case law. See e.g., Ecolochem, Inc. v. So. Cal. Edison Co., 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999)). The mere fact that certain reference can be combined or modified does not render unpatentable the resultant combination unless the references also suggest the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

As noted previously, the Final Office Action relies on Pauschinger for allegedly disclosing a) receiving an electronic data record by an information system, b) checking the data record by the information system for the presence of errors, and c) routing the data record to a receiver if the data record is error-free; the Final Office Action relies on Sakakibara for allegedly disclosing storing a data record in a defined access area of the information system if the data record is faulty, and the Final Office Action relies on Cilurzo for allegedly disclosing having the data record stored in the defined access area being examinable by the sender and revisable.

Pauschinger concerns and describes a franking system in which a user provides a mailing address to a data center, which checks the address for accuracy. If the address is inaccurate and not easily correctable, the user is informed of the need to correct the address. When correct, the data center sends back a postage value to be stamped on an outgoing envelope. Col. 5, line 61 to col. 6, line 13. Sakakibara concerns and describes a television receiving apparatus that discriminates between a wireless TV broadcast and a cable signal (CATV) by counting a number of stations that fall within prescribed center frequencies. In this counting process, if a frequency does not fall into a particular frequency band for CATV, error frequency data is stored in an error storage area. Col. 7, lines 1 to 9. Cilurzo concerns and describes a speech server system in which various users provide speech inputs to a central server, and the server outputs text based on the speech. Cilurzo describes displaying the text at user locations and storing the text at "user databases" at the central location; the user can correct the displayed data and store it and the user database. Col. 4, lines 55 to 60.

It is abundantly clear that each of the references relied upon deals with very different systems and technical issues and that the Office Actions to date do not provide sufficient evidence that one of ordinary skill in the art of the claimed subject matter would combine art related to (1) a mailing system, (2) a television receiving device, and (3) a speech server system, to arrive at a method for verifying electronic data records. In fact, such evidence would be impossible to find, and therefore the Office Actions to date resort to the overly general assertions that there is sufficient motivation to combine because the references all pertain generally to "managing data". It is readily apparent that the present rejection is based on nothing more than impermissible hindsight, since no motivation or suggestion to make the proposed combination has been set forth.

While the Final Office Action quotes case law as to the relevant legal standards for combining references to sustain an obviousness rejection, the Office Actions to date offer only general assertions and do not offer sufficient supportive evidence to meet those standards. It is therefore submitted that claim 1 is not rendered unpatentable by the combination of Pauschinger, Sakakibara and Cilurzo.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

### **III. Rejections of Claims 2 to 4 Under 35 U.S.C. § 103(a)**

As regards the rejections of claims 2 to 4, which depend from claim 1, it is respectfully submitted that the secondary references do not cure the critical deficiencies of Pauschinger, Sakakibara and Cilurzo, set forth above. Withdrawal of these rejections is therefore respectfully requested.

### **IV. Rejection of Claim 5 Under 35 U.S.C. § 103(a)**

Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Pauschinger, Sakakibara, Cilurzo and U.S. Patent Application Publication No. 2001/0043579. It is respectfully submitted that the combination of Pauschinger, Sakakibara, Cilurzo and U.S. Patent Application Publication No. 2001/0043579 does not render unpatentable claim 5 for at least the following reasons.

U.S. Patent Application Publication No. 2001/0043579 published on **November 22, 2001** from U.S. Patent Application Serial No. 09/827,185, filed on

April 5, 2001. The present application was filed on October 26, 2001 and claims priority to Application No. 100 53 331.0, filed in the Federal Republic of Germany on October 27, 2000. A claim of foreign priority to German Application No. 100 53 331.0 was made, inter alia, in the "Declaration and Power of Attorney," filed on February 13, 2002, and a certified copy of German Application No. 100 53 331.0 was filed on February 13, 2002. A certified English-language translation of German Application No. 100 53 331.0 is enclosed herewith. In view of the foregoing, it is respectfully submitted that U.S. Patent Application Publication No. 2001/0043579 does not constitute prior art against the present application. Withdrawal of this rejection is therefore respectfully requested.

**V. Rejections of Claims 6 to 9 Under 35 U.S.C. § 103(a)**

As regards the rejections of claims 6 to 9, which depend from claim 5, since U.S. Patent Application Publication No. 2001/0043579 does not constitute prior art against the present application, withdrawal of these rejections is respectfully requested.

**VI. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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